

### **REMARKS**

In the February 4, 2009 Office Action, all of pending claims 1-4 and 6-12 stand rejected in view of prior art. Claim 1 also was rejected for failing to indicate and claim particularly and distinctly the subject matter that Applicant regards as the invention. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the February 4, 2009 Office Action, Applicant has amended claims 1, 8 and 12 as indicated above. Thus, claims 1-4 and 6-12 are pending, with claims 1 and 12 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Claim 8 has been amended to correct a typographical error.

#### ***Claim Rejections - 35 U.S.C. §112***

In paragraph 3 of the Office Action, claim 1 was rejected under 35 U.S.C. §112, second paragraph. In response, Applicant has amended claim 1 to delete the allegedly indefinite language and better define the structural arrangement in the claim.

Specifically, the last paragraph of claim now reads "~~the pressing mechanism generating a pressing force in the axial direction, the pressing mechanism having a~~ the center of the pressing mechanism being disposed that is outside a circular path centered on the center rotation axis throughout an entire rotation of the drive shaft, the circular path having with a radius equal to a distance between the center rotation axis and an axial center line of an ~~eccentric amount of the eccentric rotation body as measured perpendicularly with respect to the center rotation axis of the drive shaft, and the center of the pressing mechanism being laterally offset~~ ~~eccentric toward the discharge ports away from the circular path a center of the cylinder side or piston side end plate of the eccentric rotation body.~~" Applicant believes that the claims now comply with 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of the rejections is respectfully requested.

#### ***Rejections - 35 U.S.C. § 102***

In paragraphs 5-8 of the Office Action, claims 1-3 and 6-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,992,032 (Barito). In response, Applicant has amended independent claims 1 and 12 to more clearly define the present

invention over the prior art of record. This rejection is respectfully traversed, especially in view of these amendments, as explained below.

Claims 1-3 and 6-11

In particular, independent claim 1 now requires, *inter alia*, the pressing mechanism generating an axial-direction pressing force with a center of the pressing mechanism being laterally offset from a center rotation axis of the drive shaft; the compression mechanism having a plurality of discharge ports configured for discharging fluid compressed in the cylinder chamber to an outside of the compression mechanism, with the discharge ports being disposed radially outwardly of the center of the pressing mechanism relative to the center rotation axis; and the center of the pressing mechanism being disposed outside a circular path centered on the center rotation axis throughout an entire rotation of the drive shaft, the circular path having a radius equal to a distance between the center rotation axis and an axial center line of the eccentric rotation body as measured perpendicularly with respect to the center rotation axis of the drive shaft, and the center of the pressing mechanism being laterally offset toward the discharge ports away from the circular path. Clearly, this structure is *not* disclosed or suggested by the Barito patent or any other prior art of record.

Specifically, the Barito patent is silent with respect to a location of a discharge port configured for discharging fluid compressed in the cylinder chamber to an outside of the compression mechanism, and thus, cannot disclose such discharge ports being disposed radially outwardly of the center of the pressing mechanism relative to the center rotation axis, as now required by claim 1. Applicant notes that scroll compressors typically utilize a centrally located discharge port configured for discharging fluid compressed in the cylinder chamber to an outside of the compression mechanism. See column 3, lines 35-36 and lines 45-46 of the Barito patent. Also, the seals 22 and 24 are centered on the center rotation axis in the Barito patent, as best understood from Figures 2-4. The seal 23 in Figure 2 is also centered. Since all the seals 22-24 of Figure 2 are centered, the pressing mechanism in Figure 2 has a pressing force that must be centered on the rotation axis of the drive shaft. The seal 23 in Figures 4 and 5 is centered on the eccentric element 10, but the seals 22 and 24 are still centered on the center of rotation. The area 13 is at intermediate pressure while the area 12 is at discharge pressure. However, the Barito patent indicates that the area 13 can be at higher pressure because the area 12 communicates with the outlet (not shown). In other words, because the rings 22 and 24 are centered on the rotation axis and the sizes/pressures of the areas 12 and 13, vary, it is impossible to determine a location of the pressing mechanism

center of the embodiment illustrated in Figures 4-5 of the Barito patent, let alone its position relative to an un-illustrated discharge outlet (i.e., that is most likely centered). Therefore, the Barito patent cannot anticipate the arrangement of independent claim 1 as now amended. Accordingly, withdrawal of this rejection of independent claim 1 is respectfully requested.

Moreover, Applicant believes that dependent claims 2, 3 and 6-11 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 2, 3 and 6-11 are further allowable because they include additional limitations, which in combination with the features of independent claim 1, are not disclosed or suggested in the prior art of record. Accordingly, withdrawal of this rejection of dependent claims 2, 3 and 6-11 is also respectfully requested.

#### Claim 12

Independent claim 12 now requires, *inter alia*, the cylinder having a slit that is formed at a portion eccentric from a center of the eccentric rotation body in a face portion opposite a face on a cylinder chamber side of the cylinder side end plate of the eccentric rotation body, the slit being disposed on only one side of the cylinder relative to the drive shaft and being open in a radially inward direction facing the drive shaft in order to receive pressure of fluid discharged outside the compression mechanism to work on the slit. Clearly, this structure is *not* disclosed or suggested by the Barito patent or any other prior art of record.

Specifically, the so-called slit (10-5, 10-7) of the Barito patent is formed on both sides as seen in Figures 2 and 4 and is not open in a radially inward direction, as now claimed. Thus, the Barito patent cannot anticipate independent claim 12. Accordingly, withdrawal of the rejection of independent claim 12 is respectfully requested.

#### ***Rejections - 35 U.S.C. § 103***

In paragraphs 10 and 11 of the Office Action, claim 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Barito in view of U.S. Patent No. 2,073,101 (Fox). In response, In response, Applicant respectfully traverses this rejection, especially in view of the amendment to independent claim 1.

The Fox patent fails to account for the deficiencies of the Barito patent with respect to independent claim 1. Specifically, the Fox patent fails to disclose a pressing mechanism whatsoever, and thus, cannot disclose or suggest a pressing mechanism center disposed relative to discharge ports as claimed. Also, since the seals of the Barito patent move and/or are centered on the eccentric part of the drive shaft, even if used with the C-shaped piston

type compressor of the Fox patent, a pressing mechanism center is either centered or it's location is undeterminable. Note Figure 2 of the instant application as compared to Figures 3 and 5 of the Barito patent. Accordingly, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents, and then further modifying the hypothetical device created by such a hyp[othetical combination to result in Applicant's unique arrangement of independent claim 1, as now amended.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-4 and 6-12 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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